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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/564,774

06/19/2006

Joachim Zimmerman

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LAMBERT & ASSOCIATES, P.L.L.C.
92 STATE STREET
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EXAMINER

HOPKINS, CHRISTINE D

ART UNIT

PAPER NUMBER

3735

MAIL DATE

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PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No. 10/564,774	Applicant(s) ZIMMERMAN, JOACHIM	
	Examiner CHRISTINE D. HOPKINS	Art Unit 3735	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 10 November 2008.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-13 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☒ Claim(s) 2-13 are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 13 January 2006 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☒ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

1. This Office Action is responsive to the Amendment filed 10 November 2008. Claims 1-13 are now pending. The Examiner acknowledges the addition of claims 2-13.

Election/Restrictions

2. Newly submitted claims 2-13 are directed to an invention that is independent or distinct from the invention originally claimed for the following reasons: claims 2 and 8 recite "an annularly shaped element;" "an annularly shaped inert tube," and "a plurality of magnetized balls" or "magnetized rings." It is submitted that this combination of elements is separate and distinct from that previously presented in the original claims, which comprises "an inert tube" and "magnetized or magnetizable balls." Furthermore, the specification does not provide support for the combination of these three elements, rather it only provides support for "an inert tube" having "magnetized or magnetizable balls."

Since applicant has received an action on the merits for the originally presented invention, this invention has been constructively elected by original presentation for prosecution on the merits. Accordingly, claims 2-13 are withdrawn from consideration as being directed to a non-elected invention. See 37 CFR 1.142(b) and MPEP § 821.03.

Drawings

3. The drawings are objected to under 37 CFR 1.83(a). The drawings must show every feature of the invention specified in the claims. Therefore, the arrows portraying magnetic attraction between two permanent magnets must be shown or the feature(s) canceled from the claim. No new matter should be entered.

Corrected drawing sheets in compliance with 37 CFR 1.121(d) are required in reply to the Office action to avoid abandonment of the application. Any amended replacement drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. The figure or figure number of an amended drawing should not be labeled as “amended.” If a drawing figure is to be canceled, the appropriate figure must be removed from the replacement sheet, and where necessary, the remaining figures must be renumbered and appropriate changes made to the brief description of the several views of the drawings for consistency. Additional replacement sheets may be necessary to show the renumbering of the remaining figures. Each drawing sheet submitted after the filing date of an application must be labeled in the top margin as either “Replacement Sheet” or “New Sheet” pursuant to 37 CFR 1.121(d). If the changes are not accepted by the examiner, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

Claim Rejections - 35 USC § 112

4. The following is a quotation of the first paragraph of 35 U.S.C. 112:

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The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

5. Claim 1 is rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the enablement requirement. The claim contains subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention. The specification of the instant application fails to describe how a pulsating magnetic field is generated by the magnetized or magnetizable balls or rings.

6. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

7. Claim 1 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. It is unclear as to what defines an "attractive alignment" or "opposite alignment" as recited at lines 8 and 10, respectively. For instance, the limitations may be interpreted to be "attractive" for aesthetic purposes and "opposite" meaning each magnetized element is located in the ring opposite to another.

Claim Rejections - 35 USC § 101

8. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

9. Claim 1 is rejected under 35 U.S.C. 101 because the disclosed invention is inoperative and therefore lacks utility. At line 8, the claim recites “magnetized or magnetizable balls” arranged in a tube to form a ring. Such features would not produce any effect such that a therapeutic benefit would be induced upon a subject. Furthermore, pulsating magnetic field therapy relies upon the use of a coil and signal generator in order to produce a therapeutic magnetic field. The claim is silent with respect to these features.

Claim Rejections - 35 USC § 102

10. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

11. Claim 1 is rejected under 35 U.S.C. 102(b) as being anticipated by Ansari (U.S. Patent No. 3,805,777). Ansari teaches an intrauterine device comprising a ring embedded with magnets. Regarding claim 1, Ansari discloses a device **10**, in the form of a ring, also made of an inert, elastically deformable material. Magnetic rings segments, or “magnetized balls,” **18**, capable of radiating a pulsating magnetic field, are introduced into the ring **10** and are arranged in opposite alignment (col. 3, lines 26-45 and Figs. 1-2). The segments are interpreted as balls based on the evidence provided by the figures of a roundish body. The device is capable of being placed within the vagina or uterine cavity (col. 3, lines 53-55).

Response to Amendment

12. The declaration under 37 CFR 1.132 filed 10 November 2008 is insufficient to overcome the rejection of claim 1 based upon 35 U.S.C. 101 and 35 U.S.C. 102(b) as set forth in the last Office action because: it fails to set forth facts to provide for the instant invention's utility or novelty. In other words, a mere statement of "successful treatment," as indicated by Applicant, lacking any further evidence or scientific showing based on numerous patients does not provide for the invention's utility or functionality. Furthermore, statement that the instant invention's "novel design" overcomes that of the device to Ansari is insufficient to overcome the rejection to Ansari. Additionally, the declaration refers only to the system described in the specification, and not to the individual claims of the application. For instance, Applicant simply notes that the instant invention includes definite and specific alignments to ensure one of two fields, either attractive or repulsive, and the prior art places the magnetic elements in a random orientation. Therefore, the declaration does not show that the evidence is commensurate in scope with the claims.

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Response to Arguments

13. Applicant's arguments filed 10 November 2008 with respect to the rejection of claim 1 under 35 U.S.C. 112, first paragraph as failing to comply with the enablement requirement, has been fully considered and is not persuasive. Applicant contends that the creation of a magnetic field from oppositely charged magnetic elements is known in

the art and inherent from the specification as filed. Therefore, it is known that a permanent magnet produces its own persistent magnetic field. However, this argument is not persuasive. While that statement is found to be true regarding the physical nature of a permanent magnet, the specification is silent with respect to a *permanent* magnet. Furthermore, while the new drawings depict what would constitute magnetic attraction between *permanent* magnets, the drawings and specification as originally filed fail to disclose this feature. In view of the foregoing, the rejection of claim 1 under 35 U.S.C. 112, first paragraph has been maintained.

14. Applicant's arguments filed 10 November 2008 with respect to the rejection of claim 1 under 35 U.S.C. 112, second paragraph, has been fully considered and is not persuasive. Applicant contends that newly submitted Fig. 2 now shows magnetic attraction via the arrows. However, this argument is not persuasive. As the claim is written and based on the original specification, the limitations may be interpreted to be "attractive" for aesthetic purposes and "opposite" meaning each magnetized element is located in the ring opposite to another. Therefore, reading the argument of a permanent magnet into the claims is not found persuasive because it is unclear as to what constitutes the terms "attractive" and "opposite" with no mention of a permanent magnet in the specification. In view of the foregoing, the rejection of claim 1 under 35 U.S.C. 112, second paragraph has been maintained.

15. Applicant's arguments filed 10 November 2008 with respect to the rejection of claim 1 under 35 U.S.C. 101 have been fully considered and are not persuasive.

Applicant has submitted a declaration stating that the claimed invention has been used for years to relieve medical complaints of individuals, as so stated in the specification, thus attesting to the utility and functionality of the instant invention. However, this argument is not persuasive. A mere statement of "successful treatment" lacking any further evidence or scientific showing based on numerous patients does not provide for the invention's utility or functionality.

Applicant further contends that the courts have held that '...where the mode of operation alleged can be readily understood and conforms to known law of physics and chemistry, operativeness is not questioned, and no further evidence is required.' However, this argument is not persuasive. Again, if the specification made note of a permanent magnet, the mode of operation of magnetic attraction would be readily understood. The instant specification does not make mention of this type of magnet, therefore, the invention lacks functionality and utility.

Applicant also contends the interpretation of a pulsating magnetic field. A pulsating magnetic field involves the use of a coil and signal generator, as is understood when dealing with therapeutics. Moreover, even if this were not the case, it would be unknown what type of magnetic field were generated from the magnets as disclosed in the specification since it lacks any description with regards to the magnets themselves short of their annular structure. Applicant further contends that it is inappropriate for the Examiner to make statements and opinions regarding medical treatment. The

statements presented are based upon a lack of the instant invention's utility or functionality based upon the specification in its entirety, as originally filed. In view of the foregoing, the rejection of claim 1 under 35 U.S.C. 101 has been maintained.

16. Applicant's arguments filed 10 November 2008 with respect to the rejection of claim 1 under 35 U.S.C. 102(b) citing Ansari ('777) have been fully considered and are not persuasive. Applicant contends that Ansari is silent with respect to the orientation of the magnets within the device; that placement of a negative pole of one magnet next to the positive pole of an adjacent magnet creates attractive forces between the magnets, thereby giving "an attractive alignment." However, this argument is not persuasive. In response to applicant's argument that the references fail to show certain features of applicant's invention, it is noted that the features upon which applicant relies (i.e., placement of a negative pole of one magnet next to the positive pole of an adjacent magnet) are not recited in the rejected claim. Furthermore, as previously mentioned, it cannot be ascertained from the claim or the specification as originally filed, that such an "attractive alignment" results from magnetic forces and not, for instance, aesthetic purposes. Applicant notes that an "attractive alignment" produces a calming, harmonizing effect in the specification. The Examiner has interpreted this to mean an alignment which is aesthetically pleasing to a user. Thus, Ansari is believed to anticipate this limitation since its "magnetized or magnetizable balls" are featured in the same alignment as that of the instant invention (see Fig. 2 of Ansari). In view of the

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foregoing, the rejection of claim 1 under 35 U.S.C. 102(b) citing Ansari ('777) has been maintained.

Conclusion

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to CHRISTINE D. HOPKINS whose telephone number is (571)272-9058. The examiner can normally be reached on Monday-Friday, 7 a.m.-3:30 p.m..

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Charles Marmor, II can be reached on (571) 272-4730. The fax phone

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number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

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